

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed October 18, 2004 (“*Office Action*”). Claims 1-12, 14-32, and 34-105 were pending in the Application and stand rejected. Applicants respectfully request reconsideration and favorable action in this case.

Claim Rejections - 35 U.S.C. § 102

The Examiner rejects Claims 1-12, 14-32, and 34-105 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,711,166, which issued to Amir (“*Amir*”). To anticipate a claim, a single prior art reference must describe, either expressly or inherently, each and every element of the claim. M.P.E.P. § 2131.

Applicants’ independent Claim 1 recites:

A system capable of performing state-based signaling on behalf of a stateless client, comprising:

a controller, couplable to a state-based terminal, that translates at least one stateless signaling message received from said stateless client to at least one state-based signaling message for presentation to said state-based terminal thereby facilitating a media stream communications session between said stateless client and said state-based terminal using an Internet Protocol (IP)-based network, wherein the media stream communications session is comprised of packets exchanged between said stateless client and said state-based terminal.

Applicants respectfully submit that *Amir* fails to describe every element of this claim.

Among other aspects of Claim 1, *Amir* fails to describe “facilitating a media stream communications session between said stateless client and said state-based terminal using an Internet Protocol (IP)-based network, wherein the media stream communications session is comprised of packets exchanged between said stateless client and said state-based terminal.” As teaching this element, the Examiner cites generally to *Amir*’s discussion of protocol converters located in switches coupled to analog, ISDN, and H.323 telephones. *See Office Action*, at page 2; *Amir*, Figures 1 and 2A. The switches convert voice and video signals received from analog and ISDN telephones into packets, multiplex the packets with other packets received from H.323 telephones, and forward the multiplexed packets over a packet network. *Amir*, at col. 9, lines 47-62. The switches also receive multiplexed packets from

the packet network, convert selected packets into voice and video signals, and transmit the signals and/or packets to their intended destinations. *Id.* Thus, *Amir* discloses switches that transmit and receive packets on behalf of analog and ISDN telephones. However, switches that transmit and receive packets on behalf of analog and ISDN telephones fail to describe, either expressly or inherently, a controller performing state-based signaling on behalf of a stateless client, where the stateless client is capable of exchanging packets for a resulting media stream communications session. Furthermore, *Amir* fails to describe “facilitating a media stream communications session between said stateless client and said state-based terminal using an Internet Protocol (IP)-based network, wherein the media stream communications session is comprised of packets exchanged between said stateless client and said state-based terminal.”

For at least these reasons, Applicants respectfully submit that *Amir* fails to describe, either expressly or inherently, each and every element of independent Claim 1. For analogous reasons, Applicants respectfully submit that *Amir* fails to describe, either expressly or inherently, each and every element of independent Claims 16, 21, 36, 41, 51, 56, 66, 71, 76, 81, 87, 89, 91, and 99. Thus, for at least these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of independent Claims 1, 16, 21, 36, 41, 51, 56, 66, 71, 76, 81, 87, 89, 91, and 99 as well as their respective dependent claims.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejects Claims 1-12, 14-32, and 34-105 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,726,984, which issued to Kubler, et al. (“*Kubler*”), in view of *Amir*. To establish obviousness of a claimed invention under § 103, all claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03. Furthermore, the Examiner must point to some teaching, suggestion, or motivation to combine or modify the teachings of the prior art to produce the claimed invention either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of the invention. *Id.* § 2143.01.

Again, Applicants’ independent Claim 1 recites:

A system capable of performing state-based signaling
on behalf of a stateless client, comprising:

a controller, couplable to a state-based terminal, that translates at least one stateless signaling message received from said stateless client to at least one state-based signaling message for presentation to said state-based terminal thereby facilitating a media stream communications session between said stateless client and said state-based terminal using an Internet Protocol (IP)-based network, wherein the media stream communications session is comprised of packets exchanged between said stateless client and said state-based terminal.

Applicants respectfully submit that *Kubler* and *Amir*, whether taken alone or in combination, fail to teach or suggest every element of this claim.

Among other aspects of Claim 1, the *Kubler-Amir* combination fails to teach or suggest “facilitating a media stream communications session between said stateless client and said state-based terminal using an Internet Protocol (IP)-based network, wherein the media stream communications session is comprised of packets exchanged between said stateless client and said state-based terminal.” The Examiner admits that *Kubler* fails to teach or suggest this element and instead relies upon *Amir*. *Office Action*, at pages 6-7. The Examiner states that *Amir* discloses “a system for exchanging multimedia packet [sic] between the stateless and state base [sic] device.” *Id.* at page 7. To support this conclusory statement, the Examiner cites to Figure 7 of *Amir*, which illustrates an H.323 terminal, an IP telephone, an H.320 terminal, and a video interface unit coupled to a router. *Id.* However, Figure 7 simply illustrates that calls involving these devices may be distributed over IP trunks established between routers and gateways coupled to various types of networks that support packet-based communications. *Amir*, at col. 11, lines 37-65. Furthermore, the Examiner fails to point to any stateless clients in Figure 7. Applicants respectfully submit that distributing calls over IP trunks fails to teach or suggest “facilitating a media stream communications session between said stateless client and said state-based terminal using an Internet Protocol (IP)-based network, wherein the media stream communications session is comprised of packets exchanged between said stateless client and said state-based terminal.”

For at least these reasons, Applicants respectfully submit that *Kubler* and *Amir* fail to teach or suggest each and every element of independent Claim 1. For analogous reasons, Applicants respectfully submit that *Kubler* and *Amir* fail to teach or suggest each and every element of independent Claims 16, 21, 36, 41, 51, 56, 66, 71, 76, 81, 87, 89, 91, and 99.

Thus, for at least these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of independent Claims 1, 16, 21, 36, 41, 51, 56, 66, 71, 76, 81, 87, 89, 91, and 99 as well as their respective dependent claims.

Furthermore, Applicants respectfully submit that Claims 1-12, 14-32, and 34-105 are patentable over *Kubler* in view of *Amir* because there is no teaching, suggestion, or motivation to combine or modify the teachings of *Kubler* and *Amir* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

The M.P.E.P. sets forth a strict legal standard for combining or modifying references. According to the M.P.E.P., “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. § 2143.01. “The mere fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification. *Id.* (emphasis in original).

Governing Federal Circuit case law makes this strict legal standard even clearer. According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation . . . is an ‘essential component of an obviousness holding.’” *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998)). Furthermore, while “evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved, . . . [t]he range of sources available . . . does not diminish the requirement for actual evidence.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Thus, it is a factual question that cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. See *In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). Indeed, the factual inquiry whether to combine or modify references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001).

In the present case, the *Final Office Action* has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Kubler* and *Amir*. Instead, the Examiner has merely stated that the teachings of one reference would improve the teachings of another reference. Consider the *Office Action*'s only statement with regard to the combination of *Kubler* and *Amir*:

Thus, it would have been obvious to one skilled in the art at the time the invention was made to apply the teachings of the telephone (state-less client) communicating with a computer (state-based client) using packets as disclosed by *Amir* into *Kubler*'s telephone 6331 with the motivation being to enable the user of the telephone to handle both regular telephone call [sic] and reduce the long distance cost [sic].

Office Action, page 7.

Applicants respectfully submit that this statement does not provide the required evidence of a teaching, suggestion, or motivation to combine or modify the references. This statement represents the subjective belief of the Examiner, does not point to any known authority, and therefore is not based on objective evidence of record. Thus, the Examiner has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.


For this additional reason, Applicants respectfully submit that Claims 1-12, 14-32, and 34-105 are allowable over the cited references.

Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any other fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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